

390



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,339	11/18/2003	Dwight J. Lockett	DN 3723	7619

2128 7590 02/17/2005

HAVERSTOCK, GARRETT & ROBERTS LLP
611 OLIVE STREET
SUITE 1610
ST. LOUIS, MO 63101

EXAMINER

SUHOL, DMITRY

ART UNIT	PAPER NUMBER
----------	--------------

3714

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/716,339

Applicant(s)

LOCKETT, DWIGHT J.

Examiner

Dmitry Suhol

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-10 is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/18/2003</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, drawn to a reading aid, classified in class 434, subclass 181.
- II. Claim 11, drawn to a stencil for making a reading aid, classified in class 33, subclass 563.

Inventions of Group II and I are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown:

(1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the product as claimed can be made by another and materially different apparatus such as a process of utilizing a pencil, ruler and scissors but not the use of a stencil pattern.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

Art Unit: 3714

During a telephone conversation with Mary Edwards on February 11th, 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-10. Affirmation of this election must be made by applicant in replying to this Office action. Claim 11 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 5 and 6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 5, the structure encompassed by "...at least one flange on at least one of said base portion and said slide member projecting therefrom and folded over to engage a portion of the other of said base portion and said slide member" was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Although the disclosure makes it is clear how a flange member located on a slide member engages a base and slows the slide member to operate, the disclosure

Art Unit: 3714

does not address the structure or the functionality of the structure of a base having a flange member and engaging the slide member. Therefore the specification is not clear as to how to make or use the invention as claimed in claim 5.

Regarding claim 6, the specification is not clear as to how to assemble the resulting structure encompassed by claim 6. For example, it appears that claim 6 is directed to a base with an aperture with a flap hinged to a portion of the flap where the flap maybe used to cover a portion of the aperture, however the claim is directed to claim 1 which requires a slide member to occlude the aperture. Therefore it is no clear if the flap portion is considered to be the slide member or a different structure and how the flap member and slide member function together in the device. Additionally, it is pointed out that the only place that the flap member is mentioned in the specification appears to be at page 4, lines 9-11 and appears to be directed to a separate embodiment of the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Gabay '635. Gabay discloses a word isolator device containing all of the elements of the claims including, a thin elongated base portion (1) having a medially disposed aperture

Art Unit: 3714

therethrough (viewing slot 6), a thin elongated slide member that fully occludes the viewing window (panel 2), the base and slide member being positionable and complementarily engageable with one another to permit slidable movement therebetween (col. 4, lines 58-59), the slide member being dimensioned such that a viewing window may be fully or partially occluded (figure 10 and col. 5, lines 10-12), the base portion and slide member positionable to rest on a flat surface (figure 2 where it can be seen that the bottom of the device is flat and meant to be used with flat pages of text and therefore meets the above limitation). Regarding claim 2, a base portion comprising a sheet-like member folded over on to itself (figure 2 where the rectangular base 1 is considered to be sheet-like and folded over as it is formed of a sheet material and folded along respective edges and sides) to define upper and lower portions (portions above and below slot 11) and an intermediate slot therebetween (slot 11), an upper and lower portions including an elongated opening therein (opening 6), the slide member fitting within the intermediate slot of the base and slidably moveable therein to fully or partially occlude the viewing window (figure 10 and col. 5, lines 10-12). A lower portion including an outer surface adapted to abuttingly engage a generally flat surface, as required by claim 3, is shown in figure 2, where it can be seen that the bottom of the device is flat and meant to be used with flat pages of text and therefore meets the above limitation. A slide member and base member having complementary engagement portions for mating to one another and maintaining a slidable relationship, as required by claim 4, is described at col. 5, lines 6-12.

Art Unit: 3714

Allowable Subject Matter

Claims 7 and 8-10 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Harrison can be reached on 571-272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dmitry Suhol
Examiner
Art Unit 3714

ds